REMARKS

The Examiner's communication dated September 14, 2004 has been received and carefully considered. In conformance with the applicable statutory requirements, this paper constitutes a complete reply and/or a bona fide attempt to advance the application to allowance. Specifically, claims 1, 5, 9 and 13-18 have been amended and new claims 20 and 21 have been added. Reexamination and/or reconsideration of the application as amended are respectfully requested.

Summary of the Office Action

Claim 18 is objected to because of a minor informality.

Claims 1-10, 13, 15-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Ojanen (WO 02/066313A1).

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ojanen.

Claims 14 and 19 stand rejected uner 35 U.S.C. § 103(a) as being unpatentable over Ojanen in view of Smith (U.S. Patent No. 2,806,735).

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ojanen in view of Seksaria et al. (U.S. Patent No. 6,672,642).

The Claims Distinguish Patentability Over the Reference(s) of Record

Claim 1 calls for a tailgate assembly including a stamped sheet metal frame having a reinforced cross-sectional shape and a skin attached to an outer side of the frame. In rejecting claim 1, the Examiner appears to be asserting that claim 1, by its inclusion of the limitation calling for the frame to be a stamped sheet metal frame, is a product-by-process claim. The Examiner cites MPEP § 2113, which deals specifically with product-by-process claims, and asserts that claim 1 is "anticipated by Ojanen" because "[t]he process by which the frame of the tailgate assembly [of claim 1] is made is not a patentable distinction."

Applicant respectfully disagrees. Claim 1 is directed to a tailgate assembly which undoubtedly renders claim 1 an article or apparatus claim, not a product-by-process claim. In particular, claim 1 recites two (2) structural elements: a frame and a skin attached to the frame. The limitation of claim 1 calling for the frame to be a stamped sheet metal frame does not render claim 1 a product-by-process claim. Rather, it is

merely a limitation on the frame called for in claim 1 which is not taught or fairly suggested by Ojanen. Moreover, as discussed in more detail below, the frame being a stamped sheet metal frame requires certain structural limitations understood by a person of ordinary skill in the art that are not necessarily included in non-stamped sheet metal frames and thereby distinguishes patentably over Ojanen.

Assuming arguendo that claim 1 is a product-by-process claim, Applicant asserts that the limitation of claim 1 calling for a stamped sheet metal frame still requires consideration and, in this case, distinguishes patentably over Ojanen. Applicant concedes that section 2113 of the MPEP states that if the product in a product-by-process claim is the same as or obvious from a product of the prior art, then the claim is unpatentable, irrespective of whether the prior product was made by a different process. *Citing In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). However, Applicant directs the Examiners attention to the remainder of section 2113 which goes on to state that "the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art ... where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product." (emphasis added).

A "stamped sheet metal" frame differs from a non-"stamped sheet metal" frame in more than just the process in which the frame is formed. A stamped sheet metal frame includes certain structural characteristics that are not necessarily found in other frames. For example, the shapes available to a stamped sheet metal frame are often fewer than those available to other forming methods, such as extrusion, cast molding, injection molding, etc. Stamping often has the advantage of being relatively less complex and less costly, but the structure of the final stamped sheet metal product is often more limited. Accordingly, the limitation of claim 1 calling for the frame to be a stamped sheet metal frame structurally limits the frame, and is more than merely an indication of the process by which the frame is formed.

In any case, Ojanen discloses a second embodiment (Figures 5-10) wherein a rectangular tailgate 100 includes lower and upper structural members 103,105 secured to one another by end caps 131. The structural members 103,105 are said to be formed of extruded aluminum (Page 5, line 3). The end caps 131 are said to be similar to end caps 31 of a first embodiment (Figures 104), which are said to be formed of a rigid material, such as light weight steel or aluminum, by a die cast process. (Page 2, lines 37-39). With specific reference to Figure 7, each of the structural members

103,105 includes hollow/closed box sections which extend the length of the members 103,105. Structural member 103 additionally includes an arm 60 having a T-flange extending from its hollow box section. With additional reference to Figure 8, the end caps 131 each have intricate web walls (See left-most end cap 131) extending upward from an end wall and stamped bosses "presenting insert members 64,66" in the end walls. (Page 5, lines 5-7).

Applicant asserts that, due to their complex structures, neither the structural members 103,105, nor the end caps 131 are capable of being easily formed of stamped sheet metal, as called for in claim 1. The formation complexities of the closed box sections of the members 103,105 and the T-shaped flange of members 103 generally do not lend themselves to being formed by stamping. Likewise, the web walls of the end caps 131 (end caps which are said to be die cast or cast molded) are not likely to be formed of stamped sheet metal. Accordingly, Applicant respectfully submits that claim 1, which calls for a stamped sheet metal frame, is patentably distinct over Ojanen.

As should be apparent from the preceding paragraphs, the limitation of the frame of claim 1 being a stamped sheet metal frame requires certain structural features. In contrast, an extruded frame member cannot necessarily be formed of stamped sheet metal. As is known to those skilled in the art, a stamped sheet metal frame is likely to be less costly and less cumbersome than an extruded frame. Thus, Applicant submits that the stamped sheet metal frame of claim 1 necessarily imparts certain distinctive structural characteristics to the tailgate assembly frame and thereby distinguishes patentably over the references of record.

Accordingly, for at least these reasons, Applicant submits that claim 1 and claims 2-12 dependent therefrom are in condition for allowance.

As no deference was given to the preamble of claim 1 (Office Action at pages 2-3), Applicant has amended the preamble so that claim 1 clearly covers all tailgate assemblies, not just those that alternatively pivot about two axes.

Dependent claim 4 calls for structural cladding to be formed of a sheet molding compound. Citing the abstract, the Examiner asserts that Ojanen discloses a tailgate assembly having structural cladding 23a wherein the cladding is formed of sheet molding compound. Applicant respectfully asserts that the Examiner is mistaken. Ojanen explicitly discloses that panel 23a is preferably stamped from a single sheet of metal (Page 4, lines 27-30). The abstract of Ojanen states:

> A tailgate (1) for a vehicle cargo box has top (5) and bottom (3) aluminum structural members held in spaced relationship from one

> another by rigid end members. The aluminum structural members are preferably made from an extrusion process making the tailgate light and strong as well as cost effective.

Applicant has found nothing in Ojanen that discloses or fairly suggests a structural cladding formed of sheet molding compound (SMC). SMC is defined as a ready-to-mold material system that combines the reinforcement, thermosetting resin, fillers, pigments, catalysts, and other additives in a continuous sheet that is formable into complex shapes in a single molding step with minimal scrap material. *21 Kirk-Othmer, Encyclopedia of Chemical Technology 199 (4th ed. 1997).* While this exact definition of SMC should not be read into claim 6, it is provided as background information for the Examiner and supports Applicant's assertion that the sheet metal panel 23a of Ojanen does not meet the SMC limitation of claim 6. Accordingly, Applicant asserts that claim 4 is patentably distinct over Ojanen not only because claim 4 depends from claim 1, but for at least this additional reason.

Dependent claim 7 calls for the skin of claim 1 to be attached to the peripheral flange of claim 6 via welding. Quoting more product-by-process language from § 2113 of the MPEP, the Examiner rejects claim 7 as being unpatentable over Ojanen, without consideration of the limitation concerning the attachment of the skin to the flange being via welding. As already discussed, section 2113 of the MPEP makes clear the Examiner's obligation to consider limitations that imply structure, especially where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. As an example case supporting this proposition, the MPEP references *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) and indicates its holding as stating that terms such as "welded" are capable of construction as structural limitations (emphasis added).

Applying the MPEP and *In re Garnero* to claim 7, Applicant submits that attaching the skin to the flange via welding is a structural limitation and should at least be considered by the Examiner. Since there appears to be no discussion of panel 121 being welded to a peripheral flange in Ojanen, Applicant submits that claim 7 is patentably distinct over Ojanen not only because it depends from claim 1, but for at least this additional reason.

Dependent claim 8 calls for the skin of claim 1 to have a peripheral edge that mates with the frame peripheral flange for providing a welding seam. Applicant is unclear as to why the Examiner does not consider these limitation to be entirely

structural. A peripheral edge and a frame peripheral flange are both structural elements. That they mate with one another describes their structural relationship relative to one another. Accordingly, Applicant asserts that claim 8 is allowable not only because it depends from claim 1, but for this additional reason.

In reference to **dependent claims 10 and 11**, the Examiner indicates that Ojanen discloses that forming the parts (presumably of tailgate 1 or 100) by stamping would be more simple than extrusion. Applicant requests the Examiner to particularly specify where in Ojanen this indication occurs. The reference to stamping that Applicant found in Ojanen relates only to the end caps 131 having "two stamped bosses presenting insert members 64,66." There does not appear to be any discussion concerning the frame being formed of stamping, nor any discussion concerning the advantages of stamping relative to extrusion.

Moreover, Applicant challenges the Examiner's assertion that it would have been obvious to one of ordinary skill in the art to make the frame as a one piece member formed by stamping. The Examiner asserts that motivation to do so would have been to simplify the manufacturing of the frame because stamping is more simple than extrusion and one piece members take less time to assemble than multi part members. Though the act of stamping is sometimes more simple than that of extrusion, as already discussed, the structural design of a stamped part is significantly different than that of one to be formed by extrusion. For example, members with closed hollow sections and T-shaped flanges are difficult to form by stamping. Accordingly, Applicant challenges the Examiner's indication that one skilled in the art would be motivated to form the tailgate of Ojanen by a one-piece stamping process.

Accordingly, Applicant asserts that claims 10 and 11 are each allowable not only because they depend from claim 1, but for the additional reasons set forth in the preceding paragraphs.

Claim 13 calls for a sheet molding compound structural cladding to be adjacent and connected to a raised section of a frame. The Examiner asserts that Ojanen discloses "a sheet molding compound structural cladding (23a) adjacent and connected to the raised section of the frame." (Office Action at page 3). Applicant disagrees and directs the Examiner to page 4, lines 28-30 of Ojanen which states that the panel 23a is preferably stamped from a single sheet of metal. There does not appear to be any discussion in Ojanen of panel 23a being formed of sheet molding compound.

Accordingly, Applicant submits that claim 13 and claims 14-18 dependent therefrom distinguish patentably over the applied references.

Claim 19 calls for a dual-axis tailgate to include a sheet metal frame. Applicant respectfully submits that none of the references of record disclose a dual-mode tailgate frame being a sheet metal frame. Rather, Ojanen discloses a tailgate having a frame formed of extruded members 103,105 and cast molded end caps 131. There is no discussion of the frame being formed of sheet metal. Smith fails to correct this deficiency. Accordingly, Applicant submits that claim 19 distinguishes patentably over the applied references.

CONCLUSION

All formal and informal matters having been addressed, it is respectfully submitted that this application is in condition for allowance. It is believed that the claim changes clearly place the application in condition for allowance, defining over any fair teaching attributable to the references of record. Alternatively, if the Examiner is of the view that the application is not in clear condition for allowance, it is requested that the Examiner telephone the undersigned for purposes of conducting a telephone interview to resolve any outstanding differences. Accordingly, an early notice of allowance is earnestly solicited.

Respectfully submitted,

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